

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID J. WALSH

Appeal No. 1999-2624
Application No. 08/561,658

ON BRIEF

Before CALVERT, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10 and 13-18. Claims 11 and 12, which were objected to by the examiner as being dependent upon a rejected base claim in the final rejection (Paper No. 7), were canceled and re-written as new independent claim 19 and dependent claim 20

by an amendment filed October 9, 1998 (Paper No. 12), subsequent to the examiner's answer (Paper No. 11).¹ No other claims remain pending in this application.

BACKGROUND

The appellant's invention relates to a device which is particularly useful in the intubation of the lacrimal ducts (specification, page 1). A substantially correct copy of the claims on appeal is contained in the supplemental appendix filed January 10, 2000 (Paper No. 15).²

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Crawford et al. (Crawford)	4,380,239	Apr. 19,
1983		
Fugoso et al. (Fugoso)	5,545,138	Aug. 13,
1996		

(filed Feb. 28,

1994) The following rejection is before us for review.

¹According to the examiner (Paper No. 13, mailed November 18, 1998), this amendment has been entered and new claims 19 and 20 stand allowed. Claims 1-10 and 13-18 stand rejected.

²The copy of claim 1 in the supplemental appendix is inconsistent with claim 1 of record in that, in line 5, "distal" has been omitted before "end." Additionally, claims 19 and 20 should have been omitted from the supplemental appendix, since they stand allowed and, thus, are not involved in this appeal.

Claims 1-10 and 13-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crawford in view of Fugoso.

Reference is made to the brief (Paper No. 10) and the final rejection and answer (Papers No. 7 and 11, respectively) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims,³ to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we cannot sustain the examiner's rejection.

There is no dispute that the only difference between the probe set of the claims on appeal and that of Crawford lies in the joint between the proximal end of the probe of light wire

³While the wire diameter of 0.04 mm recited in claims 8 and 17 is supported by original claims 8 and 17, we note that page 5 of the appellant's specification discloses the wire diameter as about 0.4 mm. We leave this inconsistency to be resolved by the examiner and the appellant in the event of further prosecution before the examiner.

and the flexible tube. The appellant's claims require the joint to include the proximal end of the probe being contained in or engaged by a first end of the tube and a "heat shrunk sleeve" containing the first end of the flexible tube and the proximal end of the probe which applies a compressive radial pressure to attach the tube to the probe. In the Crawford probe set, on the other hand, each of the probes of wire (12, 14) is provided with a tapered enlargement (20) at the end thereof adjacent the silicone rubber tube (16). The tube "is a force fit over the end of the probes and is located by engagement with the tapered enlargement." If preferred, the tube can be bonded to the probes using a medical grade adhesive. Crawford lacks a "heat shrunk sleeve" as required by the claims.

Fugoso (Figure 6 and column 4, lines 34-46) discloses an adjustable stiffness dilation (balloon) catheter which contains a "lap joint" between a single lumen shaft (6) made of high density polyethylene material and a dual lumen shaft (14) made of high density polyethylene or nylon material. The joint comprises a "lap joint coupling sleeve" (15) which is

heat shrunk about the distal end of the dual lumen shaft and the proximal end of the single lumen shaft "which have been placed end to end."⁴ The lap joint allows the single lumen shaft and dual lumen shaft to be in fluid communication.

The examiner's position is that it would have been obvious to modify Crawford by substituting the Fugoso joint for the Crawford joint, "since it is clear that one means of connection is merely an inventive expedient for the other in the medical art, and that the joint of Fugoso will act in the new environment in the same manner it acted in the old environment" (final rejection, page 3). The examiner's stated motivation for making the modification is that:

Fugoso clearly teaches that connecting two members by means of a heat-shrinkable sleeve is a well known method of connection. Thus, the fact that Crawford relies on some sort of connection to maintain the probe and tube connected to one another, provides suggestion enough to modify that connection by substituting therefore a heat-shrinkable sleeve in order to reinforce the connection [answer, page 4].

⁴As correctly pointed out by the appellant (brief, page 7), Fugoso's Figure 6 appears to be inconsistent with this written description, in that lumen shafts (14 and 6) are shown therein as continuous.

In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

While we appreciate the examiner's observation that Crawford relies on a connection to hold the probe and tube together and that Fugoso illustrates that the use of a heat shrunk sleeve was known in the medical art at the time of the appellant's invention for use in connecting items together end to end, we are at a loss to understand why, without the benefit of the appellant's disclosure, one of ordinary skill in the art would have been led to modify Crawford to arrive at

the claimed invention. As discussed above, Crawford discloses a joint between the tube and the probe including a force fit engagement of the proximal end of the probe by a first end of the tube and, if preferred, a medical grade adhesive for bonding the tube to the probe. There is no suggestion in Crawford or in Fugoso that the Crawford joint might be inadequate for its intended purpose. It is only the appellant's disclosure (specification, pages 3-4) which informs us of any perceived deficiencies in the Crawford device. Fugoso discloses a joint not between a light metal wire probe and a flexible tube but, rather, between two nylon or polyethylene lumen shafts of a dilation catheter through which inflation fluid is passed to inflate and deflate a dilation balloon on the distal end of the catheter. According to Fugoso, the lap joint heat shrunk sleeve allows the two lumen shafts to be in fluid communication with each other. As the Crawford joint is between a metal wire probe and a tube rather than between two flexible tubes placed end to end and as there is no need for fluid to pass through the joint region between the tube and the probe of Crawford when used as

disclosed, Fugoso would not appear to us to provide any suggestion to modify the joint of Crawford.

For the foregoing reasons, we are constrained to reverse the examiner's rejection of independent claims 1 and 13 and of claims 2-10 and 14-18 which depend therefrom.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-10 and 13-18 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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